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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/107,643 06/30/98 TRACY

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QM12/1108

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| EXAMINER |
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POLUTTA, M

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| ART UNIT | PAPER NUMBER |
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3761

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DATE MAILED:

11/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/107,643

Applicant(s)

Tracy

Examiner

Mark O. Polutta

Group Art Unit

3761



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Oct 25, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The proposed amendment still does not fix the first page so that the priority is claimed correctly. See the first two lines after the field of the invention. If applicant proposes an another amendment correcting the problems, it will considered by the examiner, upon filing an appeal and brief.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

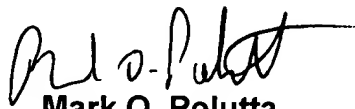
Claims rejected: 7-10

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Other See attachment.

MARK O. POLUTTA
PRIMARY EXAMINER
ART UNIT 3761

AFTER FINAL ATTACHMENT

1. Regarding the continuity, after reviewing documents submitted by applicant's representative and the file, the examiner has determined that 07/093,681 was still pending when 07/516,473 was filed. There appears to be an error regarding the date of abandonment in Office system.
2. If applicant corrects the continuity, the rejections under Foreman are still applicable. Applicant can not swear behind a 102(b) reference. Applicant can only rely on the filing date of the earlier filed design application (07/93,681) for what the application teaches. Since, Foreman was filed more than a year before the filing date of the 07/516,473 application, it is a 102(b) reference. See concerning In re Chu, 36 USPQ 2d. 1089 at 1093 (CAFC). "It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure the earlier application provides support for the claims of the later application, as required by 35 U.S.C. §112." The design application does not provide support for the claimed invention, so applicant can not rely on it for the filing date and thus swear behind the reference.
3. Regarding McConnell, the BPAI has not considered the McConnell reference as it is now being applied.
4. Regarding the double patenting rejection, applicant may file a supplemental terminal disclaimer stating that the person has 100% or the whole interest.


Mark O. Polutta
Primary Examiner
Sector 3700